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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,619	11/17/2000	Harold P. Mintz	PM 275071	5426
909	7590	11/30/2004	EXAMINER	
PILLSBURY WINTHROP, LLP			HAMILTON, LALITA M	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3624

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/714,619	Applicant(s) MINTZ, HAROLD P. 	
	Examiner Lalita M Hamilton	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on August 18, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

On February 18, 2004, an Office Action was sent to the Applicant rejecting claims 1-25. On August 18, 2004, the Applicant responded by amending claims 1-2, 14-18, and 25 and canceling claim 20.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18, 21, and 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-18, 21, and 23-24 are rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669,

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1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanborn (US 2003/0028467) in view of Street (US 2002/0010669).

Sanborn discloses a method of raising capital for early stage companies comprising operating a venture capital investment business, establishing a business

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entity, said business entity establishing an investment fund for venture capital, establishing a fund managing entity of said investment fund, said fund managing entity attending to administrative matters relating to said investment fund and making investment decisions for the fund, said investment fund having investors that provide capital contributions to said fund, said fund managing entity also providing capital contributions to said fund, said fund utilizing said contributions to invest in portfolio entities, said investors receiving a general participation interest in said fund, and said fund managing entity receiving a carried interest in said fund, and providing said investors that have provided at least a threshold capital contribution to said fund with stock rights in said business entity to enable such investors to become shareholders in said business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); fund managing entity employs at least one other fund managing entity to direct investment decisions, said at least one other fund managing entity also being provided with stock rights in said business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); portfolio entities also receive stock rights in said business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); shareholders in said business entity include direct shareholders in business entity, said investors in said fund that have exercised stock options that they obtained in said business entity, said at least one other fund managing entity that has exercised stock options that it obtained in said business entity, and said portfolio entities that have exercised stock options that they obtained in said business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); business entity invests directly in additional portfolio entities, ~~other than said portfolio entities invested in through said investment fund (p.6, 50; p.6-7,~~

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53; p.11, 88-92; and fig.1—all); an investment manager/advisor that provides investment advice to the fund (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); business entity establishes a family of investment funds, each of said funds investing in associated portfolio entities, providing investors that have provided at least a threshold capital contribution to at least one of said funds stock rights in said business entity to enable such investors to become shareholders in said business entity, and said business entity enabling shareholders thereof to purchase shares that become available in any of said portfolio entities of said family of funds (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); portfolio entities are also provided with stock rights in the business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); investment fund having investors that provide capital contributions to said fund, said fund managing entity also providing capital contributions to said fund, said fund utilizing said capital contributions to invest in portfolio entities, and providing investors that have provided a threshold capital contribution amount to said fund with stock rights to purchase shares in said business entity (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); investors are provided with stock rights to purchase shares in the business entity ms partial consideration for said shareholders agreeing for said business entity to secure rights (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); wherein receiving capital contribution information includes receiving an investor identifier associated with the investor, and based at least in part on a correspondence between the investor and the capital contribution information, retrieving the capital contribution information from a computer storage element (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); wherein allocating stock rights to the investor

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includes receiving a fund identifier associated with the fund and based at least in part on a correspondence between the fund identifier and the total capital contribution amount, retrieving the total capital contribution amount from a computer storage element (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); rights may be options or warrants (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); wherein allocating stock rights to the investor includes calculating a stock ownership percentage in the business entity, wherein said stock ownership percentage is based at least in part on the relation between the capital contribution information and a total capital contribution amount (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all); and a data storage medium, said data storage medium having machine-readable code stored thereon, the machine-readable code including instructions executable by an array of logic elements, the instructions defining a method comprising receiving capital contribution information relating to an amount of capital contributed by an investor to a venture capital fund, the fund having investments in a portfolio entities and comparing the capital contribution information to a threshold value (p.6, 50; p.6-7, 53; p.11, 88-92; and fig.1—all). Sanborn does not disclose a business entity securing a portion of IPO shares that become available in portfolio entities, and business entity enabling shareholders thereof to purchase IPO shares said portion of IPO shares secured by said business entity that become available in said portfolio entities; shareholders of said business entity will be entitled to a percentage of said portion of IPO shares that is based on a pro-rata percentage of their stock ownership in said business entity, less any shares allocated otherwise; and an amount of IPO shares that said at least one other fund managing entity is entitled to obtain is based upon the

performance of said fund and/or tenure of said at least one other fund managing entity. Street teaches a method and corresponding system for identifying potential participants in an IPO thus enabling shareholders to purchase IPO shares that become available (p.1, 13; p.2, 22-26, and p.3, 49-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the method of enabling shareholders to purchase IPO shares, as taught by Street into the method disclosed by Sanborn, to provide incentive for investing.

Response to Arguments

Applicant's arguments with respect to claims 1-19 and 21-25 have been considered but are moot in view of the new ground(s) of rejection.

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a

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copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

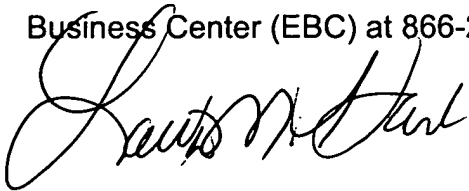
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gakidis US 2002/0095305 and Mallenbaum US 2001/0029476.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH
